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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,297	02/02/2004	Fumiaki Morishita	08917-094001	1420

26161 7590 06/06/2006

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EXAMINER
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DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/770,297

Applicant(s)

MORISHITA ET AL.

Examiner

Brian J. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

The objection to claim 11, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment corrects that claim text as appropriate.

### ***112 Rejections Withdrawn***

The rejection of claims 1-19 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment. With respect to claim 5, the amendment cancels the claim. With respect to claims 1, 3, 7 and 14-17, applicant's amendments and arguments have been carefully considered and are persuasive. The examiner is in agreement with applicant that the claims are no longer indefinite. With respect to the remaining claims, the rejection is moot.

### ***102 Rejections Maintained***

The rejection of claims 11-18, and now expanded to include claim 19, under 35 USC 102(b), outlined in the previous Office Action, is maintained for reasons of record. Applicant's amendments and arguments have been carefully considered, but are not persuasive.

With respect to the independent claim, claim 11, applicant has narrowed the claim such that a particular modification of a distillation column must be used. Applicant

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argues that such a column distinguishes the instant process from that of the prior art.

The examiner respectfully disagrees and asserts that such a distillation column must be considered a reaction vessel, or part of a reaction vessel, and case law is clear on this point: The mere selection of reaction vessel cannot impart patentability; there can be no invention even though the results are better. *In re Leum et al.*, 158 F.2d 311, 597, 72 USPQ 127 (CCPA1947).

### ***103 Rejections Withdrawn***

The rejection of claims 5 and 19 under 35 USC 103(a), outlined in the previous Office Action, has been overcome by applicant's amendment. With respect to claim 5, the amendment cancels the claim. With respect to claim 19, the amendment changes the dependency of the claim such that the rejection is moot. (Claim 19 is now included under the 102 rejection above.)

### ***103 Rejections Maintained***

The rejection of claims 1-4 and 6-10 under 35 USC 103(a), outlined in the previous Office Action, is maintained for reasons of record. Applicant's amendments and arguments have been carefully considered, but are not persuasive.

With respect to the independent claim, claim 1, applicant has narrowed the claim such that a particular modification of a distillation column must be used. As above, applicant argues that such a column distinguishes the instant process from that of the prior art. Also as above, the examiner respectfully disagrees and asserts that such a

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distillation column must be considered a reaction vessel, or part of a reaction vessel, and that the mere selection of reaction vessel cannot impart patentability. There can be no invention even though the results are better.

### ***Double Patenting***

The examiner notes for the record that the dependency of claim 19 has been changed by the amendment obviating the note regarding double patenting with claim 10.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
June 1, 2006